

REMARKS

The Office Action mailed August 17, 2009 has been reviewed and reconsideration of the above-identified application, as amended, in view of the following remarks, is respectfully requested

Claims 1-7, 9-11 and 13-23 are pending and stand rejected.

Claims 1, 19, 20, 22 and 23 are independent claims.

Claims 1, 19, 10, 22 and 23 have been amended. Claim 18 has been cancelled without prejudice.

Claims 1, 19 and 20 stand rejected under 35 USC 112, second paragraph as being indefinite for failing to distinguish between the reference to the terms "a surface." Claim 18 stands rejected under 35 USC 112, second paragraph as failing to provide positive steps for delimiting how the use is actually practiced. Claim 18 stands rejected under 35 USC 101 as being directed to a use without setting forth any steps involved in the process. Claims 1, 9-11, 13-14, 16-18 and 20-23 stand rejected under 35 USC 103(a) as being unpatentable over Aoshima (US 2003/0190551). Claims 2-7 and 19 stand rejected under 35 USC 103(a) as being unpatentable over Aoshima in view of US 6,033,752.

With regard to the rejection of independent claims 1, 19 and 20 under 35 USC 112, second paragraph, as being indefinite, Applicant respectfully disagrees with and respectfully traverses the rejection of the claims. However in order to advance the prosecution of this matter, the independent claims 1, 19 and 20 have been amended to further recite the element of the distance being between a reflecting surface of the as-deposited layer, and a reflecting surface of any reflecting layer beneath the alloy. No new matter has been added. Support for the amendment may be found at least on page 9, lines 5-11. ("In this embodiment, it is important that the distance between the surface of the as-deposited layer, and the surface of any reflecting layer beneath the alloy is

adjusted so that destructive or constructive interference is obtained between the radiation reflected from the surface of the as-deposited layer and from the surface of the reflective layer beneath the alloy."). (emphasis added).

For the amendment made to the claims to provide clarity to the subject matter claimed, applicant submits that the reason for the rejection has been overcome.

With regard to the rejections of claim 18 under 35 USC 112, paragraph and under 35 USC 101, applicant has elected to cancel this claim and remove it from further consideration at this time.

For the cancellation of claim 18, applicant submits that the reason for the rejection is no longer applicable.

Withdrawal of the rejection is respectfully requested.

Claims 1, 9-11, 13-14, 16-18 and 20-23 stand rejected under 35 USC 103(a) as being unpatentable over Aoshima (US 2003/0190551).

Applicant respectfully disagrees with and explicitly traverses the rejection of the claims.

In rejecting the claims, the Office Action asserts that the cited reference "discloses a recording medium comprising a substrate, a reflective layer, a dielectric layer, a two-layered recording layer, a dielectric layer and a cover layer. The reflective layer and the second dielectric layer are equivalent to the applicant's additional layers. The first dielectric layer may also be equivalent to applicant's spacer layer. See Figure 3 ... The thickness of the recording layers falls within applicant's disclosed range. Therefore, the medium would be capable of achieving the interference effect claimed." (see OA page 4).

However, a review of the cited reference reveals that Aoshima discloses the thicknesses of the different layers are chosen to satisfy certain manufacturing criteria and are not related to an emission wavelength, as is recited in the claims.

For example, Aoshima discloses that "the thickness of the first dielectric layer 21 and the second dielectric layer 22 is not particularly limited but is

preferably from 3 nm to 200 nm. If the first dielectric layer 21 or the second dielectric layer 22 is thinner than 3 nm, it is difficult to obtain the above-described advantages. ...if the first dielectric layer ... is thicker than 200nm it takes a long time to form the first and dielectric [sic] layers 21 and 22, thereby lowering the productivity..." See para. 0063. Aoshima further discloses that the "thickness of the first recording layer 11 and the second recording layer 12 is not particularly limited insofar as the element contained in the first recording layer 11 as primary component and the element contained in the second recording layer 12 as a primary component ...but the total thickness of the first recording layer 11 and the second recording layer 12 is preferably equal to or less than 100 nm and more preferably equal to or less than 50 nm." (see para. 0077). Further, Aoshima discloses that if the "total thickness of the first recording layer 11 and the second recording layer 12 is preferably equal to or larger than 2nm." Otherwise the change in reflection coefficient is too small. (see para. 0079).

Hence, none of the thickness ranges taught by Aoshima is selected based on a wavelength of an electromagnetic radiation.

Referring to the working examples of Aoshima disclosed in paras. 123-150, each of these examples refers to the parameters of working example 1 (i.e., second dielectric layer having a thickness of 60nm, a second recording layer having a thickness of 6nm, a first recording layer having a thickness of 6 nm and a first dielectric layer having a thickness of 60nm). The examples then disclose using different materials in the different layers. In para. [0151], Aoshima discloses the use a blue laser beam having a wavelength of 405 nm for recording information.

However, the teachings of Aoshima fails to show that the thicknesses selected for the devices in each of the working examples has any relationship to the wavelength of the laser beam used to read the information contained in the information layer.

Hence, although Aoshima discloses different ranges for the elements of the optical reading medium, Aoshima fails to disclose that the thicknesses of the elements are selected such that a distance between a reflecting surface of the as-

deposited information layer and a reflecting surface of said at least one additional layer is adjusted to be an integer multiple of a quarter wavelength of a second electromagnetic radiation, as is recited in the claims.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations. The Court in *KSR v. Teleflex* (citation omitted) has held that the teaching, suggestion and motivation test (TSM) is merely to be used as a helpful hint in determining obviousness and a bright light application of such a test is adverse to those factors for determining obviousness enumerated in the *Graham v. John Deere* (i.e., the scope and content of the prior art, the level of ordinary skill in the art, the differences between the claimed invention and the prior art and objective indicia of non-obviousness) (citation omitted).

In this case, Aoshima cannot be said to render obvious the invention claimed when Aoshima fails to disclose that the thicknesses are related to a emission wavelength or that a distance between elements of the optical recording carrier are a function of the emission wavelength, as is recited in the claims.

For the above amendments to the claims and the remarks made herein, applicant submits that the rejection of each of the independent claims has been overcome.

With regard to the remaining claims, each of these claims depends from one of the independent claims and, hence, theses claims are also not rendered obvious in view of the cited references by virtue of their dependency upon an allowable base claim.

With regard to the rejection of claims 2-7 and 19 under 35 USC 103(a) as being unpatentable over Aoshima in view of Suzuki, applicant respectfully disagrees with and explicitly traverses the rejection of the claims.

Claims 2-7 and 19 depend from one of the independent claims, which have been shown to include subject matter not disclosed by Aoshima. Suzuki discloses an optical recording medium including a substrate (2), a first recording layer (3), a second recording layer (4), a protective layer (5), and adhesive layer (6) and an upper plate (7). Suzuki discloses that radiation enters the optical recording medium through the substrate layer (2), which is transparent.

However, Suzuki fails to provide any teaching regarding setting a distance between elements as a function of an emission, as is recited in the claims.

Accordingly, the combination of Aoshima and Suzuki fails to disclose the elements recited in the independent claims and, consequently, in the aforementioned dependent claims.

For the amendments made to the claims and for the remarks made herein, applicant submits that the reason for the rejection of the claims has been overcome and respectfully requests that the rejection be withdrawn and a Notice of Allowance be issued.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or point of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action are conceded.

Applicant makes no statement regarding the patentability of the subject matter recited in the claims prior to this Amendment and has amended the claims solely to facilitate expeditious prosecution of this patent application. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the originally filed claims, as presented prior to this

Amendment, and any additional claims in one or more continuing applications during the pendency of the instant application.

In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at the telephone given below. No fees are believed necessary for the timely filing of this paper.

Respectfully submitted,
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